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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/728,128

12/04/2003

Robert B. Nilsen

1571.2018-005

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05/13/2008

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EXAMINER

SEFER, AHMED N

ART UNIT

PAPER NUMBER

2826

MAIL DATE

DELIVERY MODE

05/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/728,128 | Applicant(s) NILSEN ET AL. | |
| | Examiner Ahmed Sefer | Art Unit 2826 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 1-13,24-27,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed February 4, 2008 has been entered; no new claims have been introduced.

Election/Restrictions

2. Applicant's election with traverse of Species A detailed by fig.1 and page 5, lines 1-15 (claims 14-23) in the reply filed on 7/9/2007 is acknowledged. The traversal is on the ground(s) that the restriction requirement does not comply with the MPEP which states the Restriction Requirement are made when groups of claims to inventions are found to be either independent or distinct. This is not found persuasive because the species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record. Furthermore, Applicants have identified at least six embodiments (see page 5, lines 1-15; page 10, lines 8-22; pages 11 and 12, lines 27-29 and 1-9 respectively; page 12, lines 10-13; page 12, lines 14-26; and pages 12 and 13, lines 27-29 and 1-9 respectively.)

Applicants assert that Claim 1 was believed to be generic, with amended Claims 1-4, 10-12, 14-23 and 26-27 reading on the elected species and directed to an optical polarizer film. However, it should be pointed out that the recitation of claim 1 calling for, "an intermittent surface" is not supported by the application as originally filed and there is no discussion in the specification about an intermittent surface. Therefore, claim 1 is believed not be generic.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

3. The argument regarding the objection of claims 16 and 23 is persuasive. Therefore, the objection of claims 16 and 23 has been withdrawn. Applicant's arguments with respect to claims 14-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 14-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The application as originally filed does not specifically support the claim limitation “conductive light blocking material.” The specification merely discloses that a conductive material (see also original claim 14) disposed in at least some of the valleys. The Examiner was unable to locate any discussion in the specification about “light blocking material”.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2826

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 14- 23, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Ono (“Ono”) USPN 4,842,824

Ono discloses in figs. 1A-1C an optical polarizer film comprising a substrate 10 having a subwavelength moth-eye structure (cols. 2, lines 60-66 and the paragraph bridging cols. 2 and 3) including peaks and valleys and a conductive light-blocking material 1 disposed in at least some of the valleys providing polarization.

Re claims 15, 17 and 18, Ono discloses a conductive light-blocking material including a plurality of conductive particles or nanoparticles (**as recited in claim 17**) having a size (col. 1, lines 62-67) within the recited range (**as recited in claim 18**)

Re claims 19, 21 and 22, Ono discloses (col. 3, lines 1-48) a plurality of conductive particles including aluminum or filler (**as in claim 21**) or fibers (as recited in claim 22).

Note that the words filler, fiber conductive particles, nano-particles have been given their plain meaning as applicant has not provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004).

Re claim 16, Ono discloses (col. 3, lines 1-48) a very fine (100 nm) metal covering a concave and convex; thus, the limitation “a substantially transparent coating” is met.

Re claim 20, the claim fails to further limit the polarizer structure but only limits its method of being positioned.

Re claim 23, Ono discloses (col. 3, lines 1-48) a very fine (100 nm) metal covering a concave and convex; thus, the limitation “a substantially transparent coating” is met.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Sefer whose telephone number is (571) 272-1921

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Sue Purvis can be reached on (571) 272-1236

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. Sefer/
Primary Examiner
Art Unit 2826